

AMENDMENT UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2661
PATENT
Serial No. 09/642,980
Attorney Docket No. 1999-0587 (1014-091)

REMARKS

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Claims 2-8, 10-12, and 30-44 are now pending in this application. Claims 2, 31, and 42 are the independent claims.

I. The Obviousness Rejection

Claims 2-4, 6-8, 10-12, and 30-42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Thomas (U.S. Patent No. 6,421,339), Christie (US Patent No. 6,657,992 B1), Chau (US Patent No. 5,764,750), and/or Tiedemann (U.S. Patent No. 5,862,471). These rejections are respectfully traversed.

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP § 2143.

Each of independent claims 1 and 31 recites "translating, by the home gatekeeper, the alias address to a called routable alias address for the called H.323 entity, the called routable alias address received from a database external to a domain of the home gatekeeper and external to a domain of the H.323 entity".

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As recognized in the Office Action, Thomas does not expressly or inherently teach or suggest a "called routable alias address received from a database **external** to a domain of the home gatekeeper **and external** to a domain of the H.323 entity".

To remedy the deficiencies of Thomas, the Office Action cites Christie for "a database **external** to a domain of the home gatekeeper **and external** to a domain of the H.323 entity".

Yet, Thomas allegedly states that "[a]s will be apparent, the home network **must** be contacted first **and then** contact be made with the **visited network for instructions** on where to direct packets to the visited network". See col. 6, lines 13-20. Thus, Thomas allegedly teaches that "instructions on where to direct packets" are received from "**the visited network**".

Thomas' "instructions on where to direct packets" can be equated to the claimed "called routable alias address", and Thomas' "visited network" can be equated to the claimed "domain of the H.323 entity".

Thus, Thomas allegedly teaches and requires that the "called routable alias address" is received from a "domain of the H.323 entity" rather than from "a database... **external** to a domain of the H.323 entity". Consequently, **Thomas teaches away** from a "called routable alias address received from a **database external** to a domain of the home gatekeeper **and external** to a domain of the H.323 entity".

Because "[i]t is improper to combine references where the references teach away from their combination" (see *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983); MPEP § 2145), it is improper to combine Christie with Thomas.

The remaining references do not cure the deficiencies of Thomas or Christie. Thus, even if there were motivation or suggestion to combine Thomas with Tiedemann and/or Chau to arrive at the claimed subject matter (an assumption with which the applicant disagrees), and even if Thomas, Tiedemann, and/or Chau were combinable or modifiable (another assumption with

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which the applicant disagrees), the cited references do not expressly or inherently teach or suggest every limitation of the independent claims.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

II. Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely, claims 2-8, 10-12, and 30-44 are allowable because none of the references of record alone or in combination disclose or suggest:

“translating, by the home gatekeeper, the alias address to a called routable alias address for the called H.323 entity, the called routable alias address received from a database external to a domain of the home gatekeeper and external to a domain of the H.323 entity”.

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CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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